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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/531,179 05/31/90 ROBERTSON

S 1118A

EXAMINER

KISHORE, G

ART UNIT

PAPER NUMBER

152

DATE MAILED:

04/15/91

JAMES A. ARNO
PATENT DEPARTMENT
ALCON LABORATORIES, INC.
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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 3-4-91 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-24 are pending in the application.

Of the above, claims 6-24 are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-5 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S

15.

Applicants' amendment in paper no. 5 in which they confirm their election without traverse, of invention I, steroids as the species and dexamethasone as the ultimate species is acknowledged.

Upon reconsideration, the double patenting rejection of claims 1-5 under 35 U.S.C. 101 is withdrawn; upon reconsideration, the rejection of claims 1-5 under 35 U.S.C. 103 over Sanchez et al or Gurinder Singh is also withdrawn.

The following are the new rejections.

16.

Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 4,939,135. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claim limitations encompass the claim limitations of said patent.

17.

Claims 1-3 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited as set forth below. See M.P.E.P. §§ 706.03(n) and 706.03(z).

The term "a wound healing modulator is non enabling since it is unclear what it includes. The examiner suggests the inclusion of "dexamethasone" in claim 1 and cancellation of non elected

Serial No. 531,179

-3-

Art Unit 152

species in claim 2.

18.

Any inquiry concerning this communication should be directed to G.S.Kishore at telephone number (703) 308-2440.

hse
Kishore:ltd
April 09, 1991
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